



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,441	08/31/2001	Stephan Brunner	05306.P028	3599

7590

07/06/2005

Andre M. Gibbs  
Blakely, Sokoloff, Taylor & Zafman LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025-1030

EXAMINER

HAQ, NAEEM U

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,441

Applicant(s)

BRUNNER ET AL

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/24/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 36-39 are objected to because of the following informalities: These claims are directed to an apparatus; however, they are dependent on method claims 1, 3, and 5. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims 33-35, these claims are directed to an apparatus; however, the body of the claims merely recites a series of "logic" blocks. It is unclear to the Examiner how a "logic block" can be construed as an apparatus. The Examiner notes that a "logic block" in its broadest reasonable sense is nothing more than an instruction (i.e. program). Therefore, there is nothing in any of the claims that would constitute an apparatus.

Referring to claims 36-39, these claims are directed to an apparatus; however, they are dependent on method claims 1, 3, and 5. This dependency makes claims 36-

39 indefinite because it is unclear to the Examiner what the Applicants are attempting to claim.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 15-23, 33-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claims 1-7 and 15-23, the basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art"

Art Unit: 3625

because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present case, claims 1-7 and 15-23 are not within the technological arts because the steps recited in the method claims can be performed by hand. Indeed the Applicants' specification discloses that the steps are performed by a human (see paragraphs [0024]-[0028])

Referring to claims 33-39, these claims recite functional descriptive material (i.e. computer program) that does not impart functionality when employed as a computer component because the functional descriptive material is not tangibly embodied on a computer-readable medium. (See MPEP 2106(IV)(B)(1)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over**  
**“Java 2: The Complete Reference” hereinafter referred to as Java.**

Art Unit: 3625

Referring to claims 1-4, 7, 8-11, 14-19, 24-28, 33-36, and 39, Java teaches a method comprising: providing a set of one or more customizable product classes (pages 132 and 133); receiving a request to designate a customizable product from the set of one or more customizable product classes as a customizable product instance, and designating a customizable product class from the set of one or more customizable product classes as the customizable product instance (page 134). Java teaches that the command "Box mybox = new Box( );" accepts a request to create a customizable product instance and creates an instance of the customizable product class. Java also teaches the steps of providing a set of one or more component products, the set of one or more component products associated with the customizable product instance, and receiving a request to associate a first component product from the set of one or more component products with the customizable product instance (pages 192 and 193). The Applicants' specification teaches that component products are subclasses and inherit attributes from the customizable product class (see paragraph [0025]). Java also teaches subclasses and inheritance (pages 192 and 193). Java does not explicitly disclose the step of determining whether or not to associate the first or a second component product (i.e. subclass) with the customizable product instance. However, Java discloses that inheritance is a "cornerstone" of object-oriented programming because it allows the creation of hierarchal classifications of subclasses (page 192). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow a user to determine whether or not to associate a first, second, or third component product (i.e. subclass) with the customizable product

instance. One of ordinary skill in the art would have been motivated to do so in order to allow a user to customize the hierarchical classification to his or her needs.

Referring to claims 5, 6, 12, 13, 20-23, 29-32, 37, and 38, Java does not explicitly disclose a theme UI, control UI, group UI, discount pricing information, or instructions on how to select a class. However, the Examiner notes that these limitations are not functionally involved in the steps or elements of the recited method and apparatus. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of receiving, designating, providing, and determining would be performed the same regardless of what user interface (UI) was provided. The differences between the content of the Applicants' invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any user interface in the invention of Java because such information does not functionally relate to the steps of the claimed method or apparatus and because the subjective interpretation of information does not patentably distinguish the claimed invention.

***Response to Arguments***

Applicants' arguments with respect to the Restriction requirement in the previous Office Action have been fully considered and are persuasive. Therefore the Restriction requirement has been withdrawn.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq, Patent Examiner**



**WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**



Art Unit: 3625

Art Unit 3625

June 20, 2005